

REMARKS

The Final Office Action dated June 19, 2007 contained a final rejection of claims 1-13, 15-22 and 24. The Applicants have amended claims 1, 10, 19 and 22. Claims 1-13, 15-22 and 24 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

Record is made of a telephonic interview with Examiner Michael Bekerman on September 11, 2007 regarding the claims and the cited references. During the telephonic interview, proposed amendments to the claims were discussed in an effort to overcome the outstanding rejections. The above amendments reflect the proposals made by the Applicant during the interview.

The Office Action rejected claim 1 under 35 U.S.C. § 112, second paragraph.

In response, the Applicants have amended claim 1 as suggested by the Examiner to overcome this rejection.

The Office Action rejected claims 1-13, 15-22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Kent (U.S. Patent Publication No. 2002/0040374) in view of Zehr (U.S. Patent Publication No. 2001/0025274).

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

Specifically, the Applicants' independent claims now include using an advertising module by an advertising provider for receiving data from a service provider and for determining what advertisements, if any, would be worth placing in the media being processed. Also, the advertising module programmatically and automatically assigns a value to an advertising potential of advertisements, and based upon that value, submits a bid to the service provider for the advertising placement in the hardcopy media. Last, different values are assigned to different portions of the media depending on a location in the hardcopy media. Support for these amendments can be found throughout the specification and at least in FIGS. 1-3 and paragraphs [0023] and [0033] of the Application specification (U.S. Patent Publication No. 2002/0184092).

In contrast, the combined references merely disclose personalizing and customizing publications using subscriber profile preferences (see Figs. 1-5, paragraphs [0012], [0079], [0083], the Abstract and the Summary of Kent et al.) and automatically reducing the cost of sending an item by inserting advertisements having monetary value (see Abstract, Figs. 2-5, paragraph [0043] and the Summary of Zehr et al.).

Although the combined references disclose having an advertiser "bid-up" for a spot (see paragraph [0043] of Zehr et al.), this is very different from the Applicants' claimed using an advertising module for automatically determining what advertisements, if any, would be worth placing in the media being processed, programmatically assigning a value to an advertising potential of advertisements, and based upon that value, automatically submitting a bid to the service provider for the advertising placement in the hardcopy media, wherein different values are assigned to different portions of the media depending on a location in the hardcopy media. Clearly, the combined references are missing at least this feature and instead **explicitly** state that an advertiser can **manually** "bid-up" for a spot "...meaning whether an advertiser has indicated within the ad order processor 76 that placement of certain ads to certain types of people are worth more than others" based on their own discretion (see paragraph [0043] of Zehr et al.), **unlike** the Applicants' automatically determining what advertisements, if any, would be worth placing in the media.

Therefore, the combined references do **not** disclose, teach or suggest the Applicants' claimed an advertising module for automatically determining what advertisements, if any, would be worth placing in the media being processed, programmatically assigning a value to an advertising potential of advertisements, and based upon that value, automatically submitting a bid for the advertising placement in the hardcopy media, wherein different values are assigned to different portions of the media depending on a location in the hardcopy media.

Thus, since the combined references are missing features of the Applicants' claimed invention, the combined references cannot render the Applicants' invention obvious. This failure of the cited reference to disclose, suggest or provide motivation for the Applicants' claimed invention indicates a lack of a prima facie case of obviousness

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and, thus, the rejections should be withdrawn (MPEP 2143).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly request the Examiner to telephone the Applicants' attorney at (818) 885-1575.

Please note that all mail correspondence should continue to be directed to

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